REMARKS

This paper amends Claims 15 and 16. Claims 1-14 and 17-20 are unchanged. Claims 1-20 are pending. Reconsideration and allowance of the claims in light of the present remarks is respectfully requested. The amendments for Claims 15 and 16 are for clarification, are not meant to avoid any prior art and are not narrowing.

Discussion of Claim Rejection under 35 USC § 112, 2nd ¶

Claim 15 was rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended Claim 15 to correct the clerical error.

Discussion of Claim Rejections under 35 USC § 102(e) and § 103(a)

Claims 1, 3-6, 13-14, 17, 19 and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Zlotnick (U.S. Patent No. 6,778,703). Dependent Claims 2 and 18 were rejected under 35 U.S.C. § 103(a) as being obvious over Zlotnick.

Applicant submits herewith a Rule 131 Declaration and corresponding Exhibit A to overcome the Zlotnick patent. Specifically, Applicant submits a *Declaration under 37 C.F.R. § 131 to Overcome Zlotnick* by Jacob Joel Faul. Mark Rom is the sole inventor of Claims 1-20. However, the patent application has 37 C.F.R. § 1.47(b) status, so a representative of Cardiff Software, Inc., Jacob Joel Faul has signed the *Declaration.*

The *Declaration* includes facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued (37 C.F.R. § 1.131(a)(1) and M.P.E.P. § 715). The showing of facts are such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application (37 C.F.R. § 1.131(b) and M.P.E.P. § 715).

The features of an automated form identification method comprising storing electronic forms data in a digital signal receiving device, receiving the electronic forms data from the digital signal receiving device at a forms processing computer, storing a plurality of form templates on the forms processing computer, each form template having a plurality of entry fields and a layout,

the layout identifying a form location for each of the entry fields, and identifying a matching form template for the received electronic forms data based on the entry field locations, as recited in Claim 1, were conceived at least by April 19, 2000. The features recited in Claims 13, 17 and 20 were also conceived at least by April 19, 2000.

Due diligence in reducing the invention to practice or actual reduction to practice was made from at least prior to April 19, 2000 (the effective date of the Zlotnick reference) to at least the filing date of U.S. provisional Patent Application No. 60/242,369. Applicant hired its own patent attorney, Mr. Cantor, who filed patent applications on behalf of Applicant beginning in the year 2000. Mr. Cantor requested the draft patent from Applicant's outside patent counsel prior to April 19, 2000 (the effective date of the Zlotnick reference) so that the patent application could be completed and filed by him. The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. See *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.). As can be seen in the table below, Mr. Cantor, in addition to his other duties as in-house patent counsel, completed or prepared and then filed multiple patent applications during the time period between April 19, 2000 (the effective date of the Zlotnick reference) and the filing date of U.S. provisional patent application No. 60/242,369.

Filing Date	Application No.
03/23/00	60/191,537
06/17/00	60/212,299
06/27/00	60/214,522
09/07/00	09/656,719
10/21/00	60/242,369

Since the Zlotnick application (Appl. No. 09/553,122) was filed on April 19, 2000, Applicant submits that Zlotnick is removed from use as a reference for at least such claim limitations. Since Claims 2-12 are dependent on independent Claim 1, Claims 14-16 are dependent on independent Claim 13, and Claims 18-19 are dependent on independent Claim 17, pursuant to 35 U.S.C. § 112, ¶4, they incorporate by reference all the limitations of the claim to which they refer and include their own patentable features. Therefore, the rejection of the dependent claims has also been overcome.

Therefore in view of the above, it is submitted that Claims 1-20 are clearly distinguished from Zlotnick and are patentable. Applicant respectfully requests the withdrawal of all claim rejections and prompt allowance of the claims.

Allowed Claims

The Office Action of September 15, 2004 states that Claims 7-12 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

In light of the above, reconsideration and withdrawal of the outstanding rejections are specifically requested. In view of the foregoing remarks, Applicant respectfully submits that the claims of the above-identified application are in condition for allowance. However, if the Examiner finds any impediment to allowing all claims that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 1-18-2005

By: _____

Raimond J. Salenieks
Registration No. 37,924
Agent of Record
Customer No. 20,995
(619) 235-8550

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